

in view of TASKETT, and further in view of SMALL (U.S. Patent No. 5,513,117); rejected claims 7, 12, 15, 16, 20, 22, 23, and 25-27 under 35 U.S.C. § 103(a) as unpatentable over HOLSTROM in view of SMALL; and rejected claim 30 under 35 U.S.C. § 103(a) as unpatentable over HOLSTROM in view of TASKETT, and further in view of MACWILLIAMS et al. (U.S. Patent No. 6,385,860). Applicant respectfully traverses these rejections. Claims 1-4 and 6-30 remain pending.

Claims 1, 3, 4, 6-11, 13, 14, 16-19, 21, 22, 24, 28, and 29 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over HOLSTROM in view of TASKETT. Applicant respectfully traverses this rejection.

HOLSTROM is directed to a lost article tracking system (Abstract).

TASKETT is directed to a refundable prepaid telephone card (Abstract).

In contrast, the present invention recited in independent claim 1, for example, includes a multipurpose calling card that includes a calling card portion and a key ring portion that is separable from the calling card portion. The size of the multipurpose calling card is approximately the size of a conventional calling card. HOLSTROM and TASKETT do not disclose or suggest this combination of features.

For example, HOLSTROM and TASKETT do not disclose a multipurpose calling card that includes a calling card portion and a key ring portion. The Examiner relied on Figs. 1 and 2 of HOLSTROM for allegedly disclosing these features (Office Action, pg. 2). Applicant submits that these sections of HOLSTROM do not disclose or suggest a multipurpose calling card that includes a calling card portion and a key ring portion.

Figs. 1 and 2 of HOLSTROM depict front and back views of a two-piece detachable card, including a base 10 and a tag 12, that is used for tracking lost articles. As disclosed by HOLSTROM, a user may attach tag 12 to an article, such as a key ring, and place base 10 in a secure place, such as a wallet (col. 3, lines 3-8). If the key ring is subsequently lost, the person finding the key ring may call the number 22 listed on tag 12 and leave a voice message for the owner of the key ring (col. 3, lines 9-21). The owner may retrieve the voice message by dialing the number 24 on base 10 (col. 3, lines 22-29).

Contrary to the Examiner's allegation, HOLSTROM does not disclose or suggest that base 10 is a calling card portion, as required by Applicant's claim 1. By stark contrast, HOLSTROM's base 10 is merely a card that displays a telephone number that an user may call to retrieve a voice message left by someone finding tag 12.

HOLSTROM and TASKETT do not further disclose that the size of the multipurpose card is approximately the size of a conventional calling card, as also recited in Applicant's claim 1. The Examiner relied on col. 2, lines 47-53, of HOLSTROM for allegedly disclosing this feature (Office Action, pg. 2). This section of HOLSTROM does not disclose or suggest this feature of claim 1.

Col. 2, lines 47-53, of HOLSTROM discloses:

A typical embodiment of the two-piece detachable card of the present invention is illustrated in FIG. 1 (front view) and FIG. 2 (back view). In the preferred embodiment, the two-piece detachable card is flexible plastic similar in scope to a standard credit card. However the invention can consist of other material such as rubber, wood, metal, cardboard, paper, etc.

While this section of HOLSTROM discloses that the two-piece detachable card can be made from a material that is similar to that used in standard credit cards, this section of

HOLSTROM does not disclose or suggest that the size of the two-piece detachable card is approximately the size of a conventional calling card.

The Examiner relied on TASKETT solely for its alleged teaching of separating a card into two portions by means of perforations. Applicant notes that Applicant's claim 1 does not require that the calling card portion and key ring portion be separable by "means of perforations," but merely recites that the key ring portion is separable from the calling card portion.

For at least the foregoing reasons, Applicant submits that claim 1 is patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination.

Claims 3, 4, and 6 depend from claim 1. Therefore, Applicant submits that these claims are patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

Claim 7 recites receiving personal information, generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion, and customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information. Applicant submits that HOLSTROM and TASKETT do not disclose this combination of features.

For example, HOLSTROM and TASKETT do not disclose receiving personal information or customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information. The Examiner relied on Fig.

1 of HOLSTROM for allegedly disclosing these features and alleged that "[t]he personal information would simply read on the card user identifier such as displayed by Holstrom" (Office Action, pg. 3). Applicant disagrees with the Examiner's interpretation of the HOLSTROM disclosure.

Fig. 1 of HOLSTROM discloses a front view of a two-piece detachable card that includes a base 10 and a tag 12. Base 10 includes a base number 18 and tag 12 includes a tag number 20 (see col. 2, lines 30-35). HOLSTROM discloses that a person finding tag 12 may call the number 22 listed on the back of tag 12 (col. 3, lines 9-14). Upon calling the number, the finder may be prompted to enter tag number 20 (col. 3, lines 14-16). By entering tag number 20, the finder may leave a voice message for the owner (col. 3, lines 16-21). In a similar manner, the owner may use base number 18 to access the voice message (col. 3, lines 22-29).

HOLSTROM in no way discloses or suggests that base number 18 and tag number 20 are personal information. Put another way, HOLSTROM does not disclose or suggest that the owner of the two-piece detachable card may customize the two-piece detachable card with base number 18 and tag number 20.

For at least the foregoing reasons, Applicant submits that claim 7 is patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination.

Claims 8-11, 13, and 14 depend from claim 8. Therefore, Applicant submits that these claims are patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 8.

Moreover, these claims are patentable over HOLSTROM and TASKETT for reasons of their own.

For example, claims 8-11 recites that the multipurpose cards are multipurpose calling cards, multipurpose prepaid telephone cards, multipurpose gift cards, multipurpose credit cards, respectively. With respect to claims 8-11, the Examiner alleged that "[t]he combination including Taskett renders obvious the claimed subject matter because the ability to separate a card into two portions to include a key tag portion can be applied to any cards including a prepaid or calling cards as taught by Taskett" (Office Action, pg. 4). The Examiner's allegation in no way addresses the features of claims 8-11. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 8-11.

For at least these additional reasons, Applicant submits that claims 8-11 are patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination.

Claim 13 recites adding the personalized information to both the main portion and the keytag portion of each multipurpose card. The Examiner relied on the Figs. 1-4 of HOLSTROM for allegedly disclosing this feature (Office Action, pg. 4). As set forth above with respect to claim 7, HOLSTROM does not disclose or suggest the ability to add personalized information to a multipurpose card. Therefore, HOLSTROM cannot disclose adding the personalized information to both the main portion and the keytag portion of each multipurpose card.

For at least these additional reasons, Applicant submits that claim 13 is patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination.

Claims 16 and 22 recite features similar to those features described above with respect to claim 7. Therefore, Applicant submits that claims 16 and 22 are patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination, for reasons similar to those given above with respect to claim 7.

Claims 17-19 and 21 depend from claim 16. Therefore, Applicant submits that these claims are patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 16.

Claim 24 depends from claim 23. Therefore, Applicant submits that this claim is patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 24.

Claim 28 recites features similar to those features described above with respect to claim 1. Therefore, Applicant submits that claim 28 is patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination, for reasons similar to those given above with respect to claim 1.

Claim 29 depends from claim 1. Therefore, Applicant submits that this claim is patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 28. Moreover, claim 29 is patentable over HOLSTROM and TASKETT for reasons of its own.

Claim 29 recites creating 5 or 6 perforations between the first calling card portion and the second portion. With respect to this feature, the Examiner alleged that "the number of perforations would be a design choice" (Office Action, pg. 5). The Examiner's allegation is merely conclusory and insufficient for establishing a *prima facie* case of obviousness.

For at least this additional reason, Applicant submits that claim 29 is patentable over HOLSTROM and TASKETT, whether taken alone or in any reasonable combination.

Claim 2 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over HOLSTROM in view of TASKETT, and further in view of SMALL. Applicant respectfully traverses this rejection.

SMALL is directed to a vending machine that allows a customer to design and personalize a greeting card (Abstract).

Claim 2 depends from claim 1. Applicant submits that the disclosure of SMALL does not remedy the deficiencies in the disclosures of HOLSTROM and TASKETT set forth above with respect to claim 1. Therefore, Applicant submits that claim 2 is patentable over HOLSTROM, TASKETT, and SMALL, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Moreover, this claim is patentable over HOLSTROM, TASKETT, and SMALL for reasons of its own.

Claim 2 recites that the key ring portion includes one or more of promotional information, personal expressions, and photographs. The Examiner admitted that

HOLSTROM and TASKETT do not disclose this feature and alleged that "[i]t's notoriously well known to have designs or advertisements by a card producer or telephone provider displayed on a calling card. Small teaches an apparatus for dispensing personalized gifts wherein a user can personalize information on a gift which according to Small could include prepaid telephone calling cards" (Office Action, pg. 6). Applicant disagrees.

The Examiner's allegations do not address the features recited in Applicant's claim 2. As set forth above, claim 2 recites that the key ring portion includes one or more of promotional information, personal expressions, and photographs. The Examiner allegation that placing designs and advertisements on calling cards is notoriously well known, regardless of its veracity, does not address the placement of one or more of promotional information, personal expressions, and photographs on a key ring portion of a multipurpose calling card.

The Examiner relies on SMALL for allegedly supporting the allegation that placing designs and advertisements on calling cards is notoriously well known (Office Action, pg. 6). Regardless of the veracity of this allegation, the Examiner does not allege and SMALL does not disclose the placement of one or more of promotional information, personal expressions, and photographs on a key ring portion of a multipurpose card, as required by Applicant's claim 2.

The Examiner further alleged with respect to claim 2 that "[t]he combination fails to teach the possibility of being able to personalized the card to include personal information *as desired by the user of the card even though this limitation is not*

specifically directed to the claimed subject matter" (Office Action, pg. 6, emphasis in original). While the Examiner's allegation is difficult to understand, Applicant notes that claim 2 does not recite personalizing a card to include personal information, as alleged by the Examiner. Instead, claim 2 recites that the key ring portion of a multipurpose calling card includes one or more of promotional information, personal expressions, and photographs. Therefore, Applicant assumes that the Examiner is addressing, with respect to this allegation, a feature that is not recited in Applicant's claim 2. Applicant respectfully requests that the Examiner limit future allegations to the claimed subject matter and not to limitations that are not specifically directed to the claimed subject matter.

For at least these additional reasons, Applicant submits that claim 2 is patentable over HOLSTROM, TASKETT, and SMALL, whether taken alone or in any reasonable combination.

Claims 7, 12, 15, 16, 20, 22, 23, and 25-27 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over HOLSTROM in view of SMALL. Applicant respectfully traverses this rejection.

As set forth above, claim 7 recites receiving personal information, generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion, and customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information. HOLSTROM and SMALL, whether taken

alone or in any reasonable combination, do not disclose or suggest the features of claim 7.

For example, HOLSTROM and SMALL do not disclose customizing at least one of the keytag portion and the main portion of each multipurpose card to include received personal information. The Examiner relied on HOLSTROM for allegedly disclosing "a customized card which includes personal information which reads on the 'card identifier' wherein according to Holstrom, the card can be separated into two portion to include a key tag portion through which a key chain can be inserted in (see figs.)" (Office Action, pg. 6). Applicant submits that HOLSTROM does not disclose or suggest customizing the two-piece detachable card, illustrated in Figs. 1-3, with received personal information. As set forth in detail above, HOLSTROM does not disclose or suggest, contrary to the Examiner's allegation, that base number 18 and tag number 20 are received personal information. In fact, HOLSTROM does not disclose or suggest that the two-piece detachable card can be customized in any way.

The Examiner further alleged that "[t]he fact that the card is to be customized by the user or the party purchasing the card to include the 'personal information' is not directed to the claimed subject matter" (Office Action, pg. 6, emphasis in original). Applicant's claim 7 does not recite that the customizing is performed by a user or party purchasing the card. Again, Applicant requests that the Examiner limit future allegations to the claimed subject matter and not to limitations that are not directed to the claimed subject matter.

The Examiner relied on SMALL for allegedly disclosing "an apparatus wherein cards including prepaid telephone cards can be customized as desired by a user purchasing the card which could be a gift for a recipient" (Office Action, pp. 6-7). While not acquiescing in the Examiner's allegation, Applicant submits that one skilled in the art would not have been motivated to incorporate SMALL's alleged teaching of customizing prepaid telephone cards into the HOLSTROM disclosure, absent impermissible hindsight.

With respect to motivation, the Examiner alleged that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of Holstrom thus making it possible to customize personalized information on a card which can be used for making a call as a gift to a recipient" (Office Action, pg. 7). Applicant disagrees. HOLSTROM does not disclose or suggest a desire to customize the two-piece detachable card. Moreover, SMALL does not disclose or suggest a desire to customize a card that is used for tracking lost articles. Applicant submits that the Examiner's motivation was impermissibly gleaned from Applicant's own disclosure.

For at least the foregoing reasons, Applicant submits that claim 7 is patentable over HOLSTROM and SMALL, whether taken alone or in any reasonable combination.

Claim 12 depends from claim 7. Therefore, Applicant submits that claim 12 is patentable over HOLSTROM and SMALL, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 7.

Independent claims 15, 16, 22, and 25 recite features similar to those described above with respect to claim 7. Accordingly, Applicant submits that these claims are patentable over HOLSTROM and SMALL, whether taken alone or in any reasonable combination, for reasons similar to those given above with respect to claim 7.

Claim 20 depends from claim 16. Therefore, Applicant submits that claim 20 is patentable over HOLSTROM and SMALL, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 16. Moreover, claim 20 recites additional features not disclosed by HOLSTROM and SMALL.

Claim 20 recites that the processor is configured to add at least one of a company logo, personal expression, and a photograph to the main portion and the keytag portion of the multipurpose card. With respect to this feature, the Examiner alleged "[t]he combination teaches being able to customize a card to include information which could include personal expression" (Office Action, pg. 8). Applicant disagrees.

As set forth above HOLSTROM does not disclose or suggest customizing a card. Therefore, HOLSTROM cannot disclose or suggest customizing the main portion and the keytag portion of a multipurpose card to include at least one of a company logo, personal expression, and a photograph. Moreover, since SMALL does not disclose or suggest a card that includes a main portion and a keytag portion, SMALL cannot disclose customizing the main portion and the keytag portion of a multipurpose card to include at least one of a company logo, personal expression, and a photograph.

For at least these additional reasons, Applicant submits that claim 20 is patentable over HOLSTROM and SMALL, whether taken alone or in any reasonable combination.

Claim 23 depends from claim 22. Therefore, Applicant submits that claim 23 is patentable over HOLSTROM and SMALL, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 22. Moreover, claim 23 recites a feature similar to that described above with respect to claim 20. Therefore, Applicant submits that claim 23 is further patentable over HOLSTROM and SMALL for reasons similar to those given above with respect to claim 20.

Claims 26 and 27 depend from claim 25. Therefore, Applicant submits that these claims are patentable over HOLSTROM and SMALL, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 25.

Claim 30 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over HOLSTROM in view of TASKETT, and further in view of MACWILLIAMS et al. Applicant respectfully traverses this rejection.

MACWILLIAMS et al. is directed to a method for consistently applying and aligning labels (Abstract).

The disclosure of MACWILLIAMS et al. does not remedy the deficiencies in the disclosures of HOLSTROM and TASKETT set forth above with respect to claim 28. Since claim 30 depends from claim 28, Applicant submits that claim 30 is patentable over HOLSTROM, TASKETT, and MACWILLIAMS et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 28.

In view of the foregoing remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectively submitted,

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